

REMARKS

Claims 1-15 are pending in the application. Independent claim 1 has been amended to better define the claimed invention. Applicants respectfully request reconsideration in light of the instant amendments and/or remarks.

1. Rejection of claims 1-15 under 35 U.S.C. §103(a) as obvious over Wiemann et al., U.S. Patent No. 6,093,497, hereafter "Wiemann" in view of Bergfried et al., Canadian Patent Publication No. 2,154,818 A1, hereafter "Bergfried".

In making the rejection the PTO has asserted that it would have been obvious to one of ordinary skill in the art at the time of invention by aApplicants to use the surfactant of Bergfried in the basecoat composition of Weimann to make an aqueous pigment paste as claimed.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The instant basis of rejection fails to meet this standard. In particular, the cited combination of Weimann and Bergfried fails to disclose or suggest all of the required claim limitations of the aqueous pigment paste of independent claim 1.

For example, Applicants' claimed pigment paste of amended independent claim 1 requires that it be free of binders and grinding resins.

In contrast, Weimann is directed to a process for preparing a multilayer coating on a substrate surface. The process comprises applying an aqueous coating composition on a previously applied basecoat to form a second basecoat, applying a top coat, and baking the three coats (two basecoats and one top coat) together (Abstract).

Weimann goes into extensive detail regarding the composition of the aqueous coating composition which is based on an acrylate polymer (x) and a non-associative

thickener (y). ('497, *Abstract*) The amount of the polyacrylate (x) appears to be dependent upon the type of pigment employed, i.e., 25 -50% for organic and/or inorganic color-imparting pigments and 15-30% for special effect pigments. ('497, *col. 5, lines 6-12*) Finally, Weimann further teaches that numerous "auxiliary binders", grinding resins, and/or crosslinking agents may also be used. ('497, *co. 3, line 46 to col. 4, line 10*)

At col. 4 line 60 to col. 5, line 5 Weimann discloses the amount of pigments and fillers that may be included in the aqueous coating composition. In this passage Weimann also discloses that the pigments can be added in "any desired form, for example as an aqueous slurry or as a paste" thus making a distinction between the aqueous coating composition (with the attendant disclosure regarding the use of a thickener) that is the subject of Weimann's disclosure and a pigment slurry or paste which can be a component of Weimann's aqueous coating composition.

Thus, most importantly, nothing in Weimann teaches or suggests the use of a pigment paste that is free from binders and grinding resins. Rather, Weimann teaches that the basecoat (ii) may contain any of numerous binders.

Nor does Bergfried rectify the deficiencies of Weimann. For example, Bergfried requires that its pigment concentrate contain from 2 to 4.9% of a terpolymeric anionic polyacrylate. Such materials are binders and thus outside the scope of Applicants' claimed invention.

Finally, the combination of Bergfried's surfactant into Weimann's aqueous basecoat would simply result in a basecoat composition (containing acrylate polymer (x)) with a higher concentration of surfactant. Such a composition fails to disclose or suggest Applicants' aqueous pigment paste that must be free of binders and grinding resins. That is, Applicants note that the pending claims are drawn to an aqueous pigment paste. The teachings of Weimann with regard to the aqueous basecoat composition (ii) based on an acrylate polymer(x) cannot and do not read on a pigment paste free of binders and grinding resins.

Finally, Applicants note that the cited combination also fails to provide other required elements of the claimed aqueous pigment paste of amended claim 1. For example, although Weimann mentions pigment pastes, Weimann is silent as to the

composition of such pastes and contains no disclosure with regard to the amount of metal pigment in a paste or the use of a nonassociative thickener in a pigment paste.

Bergfried, while directed to a pigment concentrate, fails to overcome these deficiencies. For example, Bergfried does not disclose the use of a nonassociative thickener such as those required in amended independent claim 1.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03. In this case, the claimed combination fails to establish a prima facie case of obviousness because it fails to disclose or suggest an aqueous pigment paste that is free of binders and grinding resins but which contains Applicants' particularly required nonassociative thickener.

Accordingly, reconsideration and removal of the obviousness rejection of claims 1-15 is respectfully requested in view of the foregoing remarks.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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